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**REMARKS**

In view of the following discussion, the Applicant submits that none of the claims now pending in the application are made obvious under the provisions of 35 U.S.C. § 103. Thus, Applicant believes that all of these claims are now in allowable form.

**I. REJECTION OF CLAIMS 1-10 UNDER 35 U.S.C. § 103****A. Claims 1-10**

In paragraph 3 of the Office Action, the Examiner has rejected claims 1-10 under 35 U.S.C. § 103. Specifically, the Examiner has rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over Liffick (U.S. Patent No. 6,421,439, issued July 16, 2002, hereinafter "Liffick") in view of Aravamudan et al. (U.S. Patent No. 6,301,609, issued October 9, 2001, hereinafter "Aravamudan") or alternatively Aravamudan in further view of Liffick. Applicant respectfully traverses this rejection.

Liffick discloses a communication system that combines telephone and Internet technology and provides user control of a contact list used for filtering incoming telephone calls. Specifically, Liffick discloses an affiliation list that could be segmented into a series of sub lists. (See Col. 7, line 57 through Col. 8, line 5.) (*emphasis added*.)

Aravamudan discloses a unified messaging solution and services platform that utilizes instant messaging ("IM") services and communication protocols to locate a registered user, query the user for a proposed message disposition or other action, and coordinate services among a plurality of communication devices, modes and channels. (See Col. 2, lines 25-49).

The Examiner's attention is directed to the fact that Liffick and Aravamudan (alone or in any permissible combination) fail to teach or suggest an instant messaging system that includes generating a recipient user controlled instant messaging contact list; segmenting the recipient user controlled instant messaging contact list; and selection by the recipient user of various ones of the segmented contact lists and specifying a message category membership in each segmented contact list as a technique of specifying accessibility levels to messages of selected segments of the segmented contact list, as positively claimed by Applicant in independent claim 1, which

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recites:

1. In an instant messaging system, a method of controlling instant messaging access, by the steps of:  
generating a recipient user controlled instant messaging contact list;  
segmenting the recipient user controlled instant messaging contact list into a plurality of segmented contact lists;  
selection by the recipient user of various ones of the segmented contact lists and specifying a message category membership in each segmented contact list as a technique of specifying accessibility levels to messages of selected segments of the user controlled instant messaging contact list. (emphasis added)

Furthermore, Liffick and Aravamudan (alone or in any permissible combination) fail to teach or suggest the novel aspect of "[i]n an instant messaging system having a capability for sending instant messages. . . preparing a contact list of potential acceptable senders of instant messages; segmenting the contact list into a plurality of message categories and inserting selected names from the list of potential acceptable senders in selected ones of the plurality of message categories; enabling selected ones of the plurality of message categories for controlling the acceptance of instant messages from senders of the selected ones of the plurality of message categories[,]" as positively claimed by Applicant in independent claim 6, which recites:

6. In an instant messaging system having a capability for sending instant messages and monitoring an on-line status of PCs connected to a managing server/servers, a method for permitting a recipient of instant messages to control accessibility to receive instant messages from a list of potential senders, comprising the steps of:  
preparing a contact list of potential acceptable senders of instant messages;  
segmenting the contact list into a plurality of categories and inserting selected names from the list of potential acceptable senders in selected ones of the plurality of categories;  
enabling selected ones of the plurality of categories for controlling the acceptance of instant messages from senders of the selected ones of the plurality of categories. (emphasis added)

An aspect of the present invention is directed to an instant messaging ("IM")

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system having more gradations of control of IM access by differentiating between desirable messages and undesirable messages. In other words, the instant messages being sent to the recipient user are checked against a user designated category, e.g., a message category membership within each segmented contact list. In turn, accessibility levels or the acceptance of the instant messages are based on the user designated categories. Thus, Applicant's claimed invention discloses a novel method of controlling the acceptance of instant messages, in part, through specifying a user designated category in each segmented contact list.

As described in the specification (page 3, lines 3-10):

Each sub list may contain a list of potential instant messengers interested in a particular focus (i.e., issue, subject matter, etc.). Some names of potential instant messengers may be common to more than one list. Each individual sub list is by recipient selection subject to certain conditions (i.e., set by a recipient) of acceptance or non-acceptance of instant messages addressed to the recipient. Conditions may encompass items such as availability of the recipient, busyness of the recipient, relations between sender and recipient, cause of the message such as an emergency, and other status factors to be set by the recipient.

Thus, the access criteria are not just based upon individual names, telephone numbers or aliases but on the user designated category associated with the identity of the sender. This allows a highly flexible method that permits a user to specify and/or modify levels of acceptance of incoming instant messages for a particular sender or a subset of senders within a much larger list of senders.

In contrast, the alleged combination (as taught by Liffick) teaches a system and method for user affiliation in a telephone network for managing incoming calls. It is not related to the management of incoming instant messages. Thus, the user specified affiliation list in Liffick relates to telephone calls from one or more potential callers. The user can specify user-selectable call processing criteria for all incoming calls, incoming calls from selected callers, and apply conditional criteria based on user preferences. However, the disclosed user control is based upon the identification of the caller or the caller's telephone number or Internet subscriber identification.

Liffick is therefore not directed to the managing of instant messages by the user

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but rather to the controlling of telephone calls to the user. Because Liffick does not concern itself with instant messaging, there would be no need for and Liffick does not teach or suggest generating an instant messaging contact list. Likewise, there would be no need for and Liffick does not teach or suggest segmenting an instant messaging contact list. Finally, there would be no need to, and Liffick does not teach or suggest, specifying a message category membership in each of the segmented contact list. Therefore, Liffick fails as a primary reference since all the elements of Applicant's independent claims are missing in Liffick.

The significant gap left by Liffick as discussed above is not bridged by the combination of Aravamudan with Liffick. The Examiner has conceded that "Aravamudan did not specifically disclose segmenting the contact list and specifying an accessibility level of the segmented list." (See Final Office Action, Paragraph 7.) As such, combining Liffick and Aravamudan would not make Applicant's invention obvious as claimed in independent claims 1 and 6. Contrary to the Examiner's assertion that Applicant is addressing the references individually, Applicant is simply directing the Examiner's attention that if both references are missing teachings as to elements of Applicant's independent claims, then the alleged combination (if permissible) simply cannot make Applicant's invention obvious.

To illustrate, one of Applicant's position is that both references fail to disclose the concept of segmenting an instant messaging contact list. Liffick doesn't teach or suggest this element because Liffick does not have an instant messaging contact list. To cure this defect, the Examiner relies on Aravamuden for this teaching, but the Examiner conceded in Paragraph 7 that Aravamuden doesn't teach this concept. The Examiner attempted to retract this statement in Paragraph 12 of the Final Office Action that "Applicant further asserts that as Examiner previously stated that 'Aravamuden did not specifically disclose segmenting the contact list and specifying accessibility level of the segmented list', both references thus fail to disclose this limitation. Examiner submits that this assumption is wrong." However, the Examiner does not state why Applicant's assumption is wrong. Applicant has demonstrated that both references fail to provide this teaching. The Examiner is broadly applying hindsight to apply these two

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references against Applicant's invention without providing any support or motivation within the cited references for the position asserted by the Examiner.

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. Denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp. 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Applicant respectfully submits that the Examiner has failed to present a prima facie case of obviousness.

Furthermore, claims 2-5 and 7-10 depend from independent claims 1 and 6, respectively, and recite additional limitations. For the same reasons discussed above, these dependent claims are allowable.

### Conclusion

Applicant submits that all pending claims now fully satisfy the requirements of 35 U.S.C. §103. Consequently, Applicant believes that all pending claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes there are any unresolved issues requiring the

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maintenance of the present final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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